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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,727	12/06/2004	Rainer Noack	5000-0106PUS1	9942
2292 7590 08/08/2007 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			EXAMINER CHUNG, SUSANNAH LEE	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 08/08/2007	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	Application No. 10/516,727	Applicant(s) NOACK ET AL.	
	Examiner Susannah Chung	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 20-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20, 28, 32, 33 and 36-38 is/are rejected.
- 7) ☒ Claim(s) 21-27, 29-31, 34 and 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/6/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 1626

### **DETAILED ACTION**

Claims 20-38 are pending in the instant application. Claims 1-19 are canceled.

#### ***Priority***

This application is a 371 of PCT/EP03/05950, filed 06/06/2003.

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) by application no. 102-28-196.3 filed in the German Patent Office on 06/24/2002, which papers have been placed of record in the file. The application names an inventor or inventors named in the prior application.

#### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

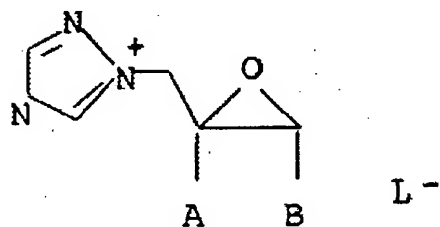
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

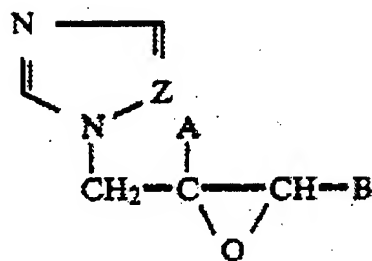
Claims 36-38 are rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 USC 103(a) as obvious over Janssen, et al (U.S. Pat. Nos. 4,652,580 ('580 Patent) and 4,906,652 ('652 Patent)).

Art Unit: 1626

Applicants claims relate to compound of Formula (IV) in claim 36,



Black discloses compounds of formula (I),



, that anticipate the instantly claimed genus

in which A and B are identical or different and independently of one another are each alkyl of 1 to 4 carbon atoms, naphthyl, biphenyl or phenyl, and the phenyl radical may be substituted by halogen, nitro, alkyl, alkoxy or haloalkyl, each of 1 to 4 carbon atoms, phenoxy or phenylsulfonyl, and Z is a CH group or nitrogen, or its physiologically tolerated salts.

The prior art teaches the instantly claimed salt, wherein the claim states that all “physiologically tolerated salts” are encompassed by the claim. The disclosure of the ‘580 Patent teaches that hydrohalic acids such as hydrochloric, hydrobromic acids can be used to make chloride and bromide salts. It also discloses that sulfuric and sulfonic acids can be used to make tosylate and mesylate salts. (See ‘580 Patent, column 3, 3<sup>rd</sup> paragraph). The instant disclosure teaches that the preferred salts include chloride, bromide tosylate, and mesylate, which are taught by Janssen. (See instant specification, page 7). Therefore, since the prior art of Janssen explicitly teaches the

Art Unit: 1626

different salt forms that can be made, it anticipates the instantly claimed 4-amino-1,2,4-triazolium salt of formula (IV).

*Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20, 28, 32, 33, 36, 37 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20 is indefinite because there are two compounds of formula (II), and the claim mentions the compound of formula (III), but the compound of formula (III) is not defined in claim 20.

Claims 28, 32 and 33 are indefinite because the terms DABCO, DBU, THF, and NMP are not defined in the claim. Acronymns may be used once they are defined in the initial claim.

Claims 36, 37, and 38 improperly depend from claim 1. Claim 1 is canceled. Claim 36 does not properly depend from any claim. It is drawn to a product claim, while the other claims, i.e. claims 20-35, are drawn to process claims. The product claim differs in form from the first independent claim from which it could depends, i.e. claim 20 a process claim.

Claims 37 and 38 recites the limitation "A 4-amino-1,2,4-triazolium salt of the formula IV as claimed in claim 36" in preamble. This is an improper dependent claim and there is insufficient antecedent basis for this limitation in the claim. The claim should read "The 4-amino-1,2,4-triazolium salt of the formula IV as claimed in claim 36" or "Said 4-amino-1,2,4-triazolium salt of the formula IV as claimed in claim 36."

Art Unit: 1626

*Objections*

Claims 21-27, 29-31, and 34-35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

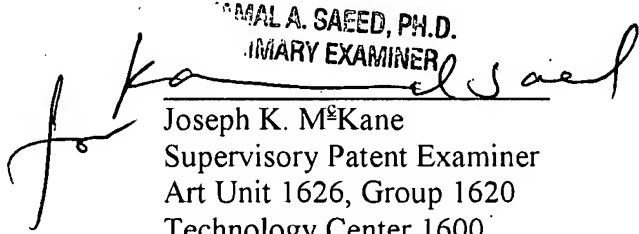
*Telephone Inquiry*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susannah Chung whose telephone number is (571) 272-6098. The examiner can normally be reached on M-F, 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLC

  
MAL A. SAEED, PH.D.  
PRIMARY EXAMINER  
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Date: 3 August 2007